

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte HIROSHI OHNISHI, KOUJI KITANO, MITSUO KAYANO
and NOBUO KURIHARA

Appeal No. 2005-2770
Application No. 09/498,856

HEARD: JANUARY 11, 2006



Before JERRY SMITH, GROSS, and LEVY, Administrative Patent Judges.
JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 12-14, which constitute all the claims pending in this application.

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The disclosed invention pertains to a control system for an automatic transmission with a torque converter.

Representative claim 12 is reproduced as follows:

12. Control system for an automatic transmission with torque converter comprising:

first input torque estimating unit for estimating an input-torque of said automatic transmission using an engine torque characteristic.

second input torque estimating unit for estimating an input-torque of said automatic transmission using torque-converter characteristic;

selecting unit for comparing the ratio between turbine revolution speed and engine revolution speed (N_t/N_e) and a threshold value, selecting an estimated value from among estimated values from the first input-torque estimating unit and the second input-torque estimating unit in accordance with the comparison result, and outputting the estimated value selected as an estimated torque value, and

control unit for controlling the automatic transmission using the estimated torque value outputted from the selecting unit.

Claims 12-14 stand rejected under 35 U.S.C. § 251 as being an improper attempt to recapture subject matter that was surrendered during prosecution of the original patent application.

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Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

HISTORY

This application is a reissue application requesting the reissue of U. S. Patent No. 5,510,982 which issued on April 23, 1996. The claims of the reissued application were rejected under 35 U.S.C. § 251 as being an improper attempt to recapture subject matter that was surrendered during prosecution of the original patent application. That rejection was appealed to the Board. In response to that appeal, the Board remanded the case to the examiner for a consideration of the appropriateness of the rejection in view of the Board's precedential decision in Ex parte Eggert, 67 USPQ2d 1716 (Bd. Pat. App. & Int. 2003). In response to the remand, the examiner maintained the rejection, and that rejection is now again on appeal before us.

OPINION

We have carefully considered the subject matter on appeal and the rejection advanced by the examiner. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the examiner's findings in support of recapture are not supported by this record. Accordingly, we reverse.

The examiner's analysis begins by noting that at least one of the following three elements was added to each one of independent claims 1, 2 and 4-7 of the application in order to obtain the patent:

1. A limitation directed to "said output torque estimation means..." was added to claims 1, 4 and 5 in the last wherein clause, and a limitation directed to "calculating said output torque..." was added to claims 6 and 7 in the last wherein clause.

2. A limitation directed to "a neural network..." was added to claim 2 in the second-to-last clause.

3. A limitation directed to "vehicle weight estimation means..." was added to claim 2 (last clause), and was also added to claim 4 (second-to-last clause).

It is the position of the examiner that none of these three elements appears in any of the reissue claims on appeal, that is, the three elements have been omitted in their entirety from the claims on appeal [supplemental answer, pages 2-4].

Appellants argue that the subject matter of this reissue application is different from the subject matter claimed in the issued patent. Specifically, appellants argue that the claims on appeal claim the contents of block 108 in Figure 10 while claim 1 of the patent is directed to the contents of block 110 [Appellants' reply, pages 1-4].

Claim 1 of the patent contained only the addition of what the examiner referred to as element 1 above. Thus, claim 1 is evidence that element 1 by itself was sufficient to provide patentability to the rejected claim. As to element 1, the wherein clause, recites the following:

wherein said output torque estimation means estimates said output torque based on torque characteristics of an engine of said drive train when a ratio between an input revolution speed and an output revolution speed of said torque converter is greater

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than a predetermined value, and based on torque characteristics of a torque converter of said automatic transmission when said ratio is less than said predetermined value.

This clause essentially recites in words that the output torque T_t on line 1022 is selected from engine torque map 1001 or torque converter-torque characteristic map 1002 based on the relationship between the ratio N_t/N_e and a predetermined value.

Claim 12 on appeal recites the following element:

selecting unit for comparing the ratio between turbine revolution speed and engine revolution speed (N_t/N_e) and a threshold value, selecting an estimated value from among estimated values from the first input-torque estimating unit and the second input-torque estimating unit in accordance with the comparison result, and outputting the estimated value selected as an estimated torque value,

This element essentially recites in words that the output torque T_t on line 1022 is selected from engine torque map 1001 or torque converter-torque characteristic map 1002 based on the relationship between the ratio N_t/N_e and a threshold (predetermined) value. In other words, it appears to us that the wherein clause of patent claim 1 requires essentially the exact

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same structure as the selecting unit of claim 12. In view of this finding, the examiner's position that claim 12 contains none of the three elements added to obtain the patent is simply incorrect. The selecting unit of appealed claim 12 is exactly the same element required by the wherein clause of patent claim 1. There can be no improper recapture where the claim in the reissue application contains all the subject matter added to the rejected claim of the application in order to obtain the patent. Since the examiner's finding that appealed claim 12 has omitted the wherein clause from patent claim 1 is erroneous, we do not sustain the examiner's rejection of claim 12.

The examiner's incorrect finding discussed above applies to appealed claims 13 and 14 as well. Although the recitations in claims 13 and 14 are not exactly the same as the recitation from claim 12 quoted above, we find that the examiner has failed to properly establish that claims 13 and 14 have omitted the wherein clause which was added to claim 1 in order to obtain the patent.

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In summary, we find that the record before us fails to support the examiner's rejection that claims 12-14 improperly recapture subject matter that was surrendered during the prosecution of the application for patent. Therefore, the decision of the examiner rejecting claims 12-14 is reversed.

REVERSED

Jerry Smith
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